

## **REMARKS**

The Office Action dated September 30, 2009, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

### **Status of the Claims**

Claims 1 and 3-10 have been amended to more particularly point out and distinctly claim the subject matter of the invention. Claims 2 and 11-13 have been cancelled without prejudice or disclaimer. New claims 50-61 have been added. No new matter has been added. Thus, claims 1, 3-10 and 50-61 are currently pending in the application and are respectfully submitted for consideration.

### **Rejection under 35 U.S.C. § 112**

On pages 2 and 3, the Office Action rejected claims 3-5 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Specifically, the Office Action stated on page 2 that “[t]here is insufficient explanation of how the same communication can be transmitted by both the mobile communication device and the network.” Claim 3 recites that the user interface has a mode where a user can cause the apparatus to communicate with the network to request transmission of the communication automatically altering the network address associated with the tag. This distinguishes that the communication by the apparatus, which may be a mobile communication terminal in some embodiments, differs from the communication transmitted by the network.

Accordingly, it is respectfully submitted that the rejection is overcome and respectfully requested that the rejection be withdrawn.

### **Rejections under 35 U.S.C. § 103**

Claims 1, 3-10, 12 and 13 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kelley et al. (U.S. Patent No. 6,728,712) in view of Kanefsky et al. (U.S. Publication No. 2002/0026500). The Office Action took the position on pages 3-10 that the combination of Kelley et al. and Kanefsky et al. teaches all of the features of the rejected claims. Applicants respectfully submit the combination of the cited art fails to teach or suggest the features of the above-rejected claims. Reconsideration of the claims is respectfully requested.

Independent claim 1, from which claims 3-7 depend, recites an apparatus including at least one processor and at least one memory including computer program code. The at least one memory and the computer program code are configured to, with the at least one processor, cause the apparatus to store a set of tags and for each tag, store an associated network address. The apparatus is also caused to provide a user interface that enables a user to select one of the tags and cause the apparatus to initiate a connection to the network address associated with the tag. The apparatus is further caused to estimate the location of the apparatus and to communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location. Additionally, the

apparatus is caused to automatically alter the network address associated with the tag in response to the communication received from the network.

Independent claim 8, from which claims 9 and 10 depend, recites an apparatus including at least one processor and at least one memory including computer program code. The at least one memory and the computer program code are configured to, with the at least one processor, cause the apparatus at least to store a set of tags and for each tag, store an associated network address. The apparatus is also caused to communicate at least one instruction containing a tag and an associated network address with at least one mobile communication terminal. The at least one mobile communication terminal is configured to communicate with the apparatus to request that the apparatus transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location.

Kelley et al. generally discusses “software for updating desired inter- or intra-net addresses at a client computer” (column 1, lines 9 and 10). “Database 14 is conventionally referred to as a bookmark database, having addresses of often-used web pages or files 26, 28 having different addresses (URLs) and accessible 24 through network server 18. As will be explained further, database 16 contains the updated addresses of the files listed on the client bookmark, and the updated addresses are used to make changes to the bookmark database 14” (column 4, lines 8-15, of Kelley et al.).

Kanefsky et al. generally discusses “the transmission of content from mobile devices to other devices through a network” (paragraph [0002]). “[A]n indication of a

URL corresponding to content accessed by a WAP/i-mode-enabled mobile device is received. Additionally a destination address is received from the WAP/i-mode-enabled mobile device. Subsequently, an indication of the URL corresponding to the content is transmitted to the destination address” (paragraph [0016] of Kanefsky et al.).

As will be discussed below, Kelley et al. and Kanefsky et al. both individually and in combination, fail to teach or suggest all of the features of the presently pending claims.

Independent claim 1 recites, in part, an apparatus configured to “estimate the location of the apparatus” and to “communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location”. Independent claim 8, which has its own scope, recites similar features. The Office Action conceded on pages 10 and 11 that the combination of Kelley et al. and Kanefsky et al. “is silent about the device comprising a location estimator for estimating the location of the mobile communication device.” Rather, the Office Action relied on paragraph [0019] of Greene. Applicants respectfully submit that Greene fails to teach or suggest the above-recited features of claim 1.

Greene generally discusses “a tracking system making use of the Internet and instant message (IM) technology” (paragraph [0001]). “[D]etermined position data (e.g., altitude, latitude and longitude) relating to the position of the wireless device is associated with user-defined location tags (e.g., ‘at home’ or ‘in the office’). Thereafter, a status update message indicating the status and/or location of the user who carries the

wireless device is sent to other wired or wireless devices, where the status update message is displayed” (paragraph [0008] of Greene). “The wireless device 13 can repeatedly send position data to the IM server 19, which translates the position data into location tags and sends status update messages to the other wired or wireless devices 11, 13” (paragraph [0019] of Greene).

The Office Action conceded on page 11 that “[t]he combination above [Kelley et al., Kanefsky et al. and Greene] is silent on whether the mobile device would transmit a communication request requesting automatically altering of the network address with a tag being in dependence on the estimated location in the format claimed.” Rather, the Office Action alleged that “[i]t would have been an obvious design choice to modify the combination such that the terminal would request transmit a communication request requesting automatically altering the network address with of a tag in dependence on the estimated location since the applicant has not disclosed that altering the network address of a tag in dependence on the estimated location would solve any stated problem or is for any particular purpose, and it appears that altering the addresses of tags manually by the user based on location would perform equally well.” However, Applicants find nothing, and the Office Action also did not provide a citation to the cited art in support of, an alleged teaching or suggestion of the above-recited features of claim 1.

The Office Action alleged on page 11 that “it appears that altering the addresses of tags manually by the user based on location would perform equally well.” However, assuming *arguendo* that this was the case, which is not admitted, there is nothing in the

cited art that teaches or suggests **automatic alteration** of addresses of tags **based on location**. For example, manual alteration requires user interaction, takes more time and is less convenient than automatic alteration. As the cited art admittedly lacks explicit disclosure of the use of tags in the context of location estimation, it cannot be said that it is within the scope of the cited art to automatically request a tag update. Rather, the combination of the cited art is crafted in the Office Action and likely did not previously exist. Automatic updating of addresses of tags based on estimated location is not supported on the record outside of Applicants' specification and cannot be derived from the cited art.

Also, the Office Action appears to be taking Office Notice that these features are allegedly obvious as an "obvious design choice". As the Office Action admitted on page 11, these features are not present in the cited art. Applicants respectfully submit that the application of Official Notice in the outstanding Office Action is improper.

With respect to Official Notice, the MPEP states that "such rejections should be judiciously applied" (see MPEP § 2144.03). The MPEP goes on to mandate that "Official notice without documentary evidence to support an [E]xaminer's conclusion is permissible only in some circumstances" (see MPEP § 2144.03(A)). "It would not be appropriate for the [E]xaminer to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of **instant and unquestionable** demonstration as being well-known" (see *Id.*, emphasis added). "For example, assertions of technical facts in the areas of esoteric technology or specific

knowledge of the prior art must **always** be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21” (*Id.*, emphasis added). Applicants note that no such support has been provided in this case. Reviewing courts must rely on the record, and the Federal Circuit has always required that absent the case where Official Notice is “instant and unquestionable”, the Office Action must provide support and reasoning for Official Notice to be proper.

In the instant case, per the above, the Office Action alleged that because Applicants have allegedly not disclosed that the above features “would solve any stated problem or is for any particular purpose”. However, per the above, the facts asserted as well-known must be capable of instant and unquestionable demonstration as being well-known, and Applicants do not believe that such is the case here. If the Examiner continues to believe that the above-recited features are well known in the art, Applicants respectfully request that the Examiner provide a reference or references in the next Office Action allegedly offering evidence that this is the case.

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

(MPEP § 2144.03(C)). The legal standard for applying Official Notice under MPEP § 2144.03 is rigorous, and Applicants respectfully submit that the present application of Official Notice falls short of meeting this high standard.

Applicants further respectfully submit that the combination of the cited art is improper because the Office Action relies on information gleaned solely from Applicants' specification and claims. MPEP § 2142 states that "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of **the facts gleaned from the prior art**" (emphasis added). "Any judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and **does not include knowledge gleaned only from applicant's disclosure**, such a reconstruction is proper" (MPEP § 2145(X)(A), quoting *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971), (emphasis added).

In the present case, the Office Action relied on a general allegation that altering addresses of tags automatically based on location is an obvious design choice. However, support for this reasoning is absent from the cited art and is only present in Applicants' specification (see, for example, claim 2 and page 6, lines 5-9). Due to the lack of any teaching or suggestion of altering addresses of tags automatically based on location in the cited art, and the fact that such disclosure is only present on the record in Applicants' specification, it logically follows that this reasoning has been improperly gleaned from Applicants' own specification and that the combination of the cited art is an exercise of



impermissible hindsight. Furthermore, the automatic alteration allegedly identified in the cited art by the Office Action is based on changing a URL for a bookmark. Nothing in the art would lead a person of ordinary skill in the art to make such an update location-dependent.

Claims 2 and 11-13 have been cancelled without prejudice or disclaimer. Claims 3-7, 9 and 10 depend from independent claims 1 or 8 and add further features thereto. Thus, the arguments above with respect to the independent claims also apply to the dependent claims.

For at least the reasons presented above, it is respectfully submitted that the cited art fails to teach or suggest all of the claimed features under 35 U.S.C. § 103(a). Accordingly, it is respectfully submitted that the rejection is overcome and respectfully requested that the rejection be withdrawn.

Claims 2 and 11 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kelley et al. in view of Kanefsky et al. and further in view of Greene (U.S. Publication No. 2002/0077080). Claims 2 and 11 have been cancelled without prejudice or disclaimer. Accordingly, it is respectfully submitted that the rejection is moot and respectfully requested that the rejection be withdrawn.

### **New Claims**

New claims 50-61 have been added. Method claims 50-59, which each have their own scope, recite similar features to apparatus claims 1 and 3-10, respectively. Independent software claims 60 and 61, which each have their own scope, recite similar

features to independent apparatus claims 1 and 8, respectively. Accordingly, it is respectfully submitted that the new claims patentably distinguish over the cited art for at least the reasons discussed above with respect to independent claims 1 and 8.

## **Conclusion**

For at least the reasons presented above, it is respectfully submitted that claims 1, 3-10 and 50-61, comprising all of the claims currently pending in the application, patentably distinguish over the cited art. Accordingly, it is respectfully requested that the claims be withdrawn and the application be passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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